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In the Supreme Court of the United States

OCTOBER TERM, 1959.

No. 622.

DON L. RUBINFIELD,
Petitioner,

vs.

ROBERT C. WATSON,
Commissioner of Patents,
Respondent.

PETITIONER'S REPLY BRIEF.

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Petitioner replies to certain matters raised by the brief for respondent, as follows:

1. Jurisdiction.

By footnote 1, on page 1, of respondent's brief, there is reference to, but not incorporation of, an argument concerning jurisdiction that had been given for the respondent in *other* cases in briefs filed therein by the Solicitor General.

Counsel for petitioner does not have access to those briefs at this time and is unaware of the argument there presented. However, in support of jurisdiction, it is to be observed:

(a) As recently as June 25, 1948, Congress recognized the jurisdiction of this Court in cases such as this by enacting 28 U. S. C. 1256, which provides:

> "Cases in the Court of Customs and Patent Appeals *may be* reviewed by the Supreme Court by writ of certiorari."

(b) As recently as April 12, 1954, this Court recognized its jurisdiction in cases such as this by adopting its present Revised Rules of the Supreme Court, including clause 2 of Rule 19, which clause provides:

> "The same general considerations outlined above will control in respect of petitions for writs of certiorari to review judgments of the Court of Claims, or of the *Court of Customs and Patent Appeals*, or of any other court whose determinations are by law reviewable on writ of certiorari."

(c) *If* this Court did not have jurisdiction by writ of certiorari to the Court of Customs and Patent Appeals, then this petitioner, who has been deprived of a patent by the lower Court's ruling of law, which is contrary to the statutes and in conflict with decisions of this Court, is denied any review whatever of such an erroneous ruling of law. The petitioner, if denied a patent under the ruling below, will not have an opportunity of trying out the same questions of a right to patent protection in any other court. In short, the ruling of law by the Court of Customs and Patent Appeals below, unless reviewed and reversed by this Court, is *final*.

(d) *If* the petitioner had elected another available avenue of appeal from the decision of the Patent Office, that is by filing a civil action, under the provisions of 35 U. S. C. 145, against the Commissioner of Patents in the District Court for the District of Columbia (instead of appealing to the Court of Customs and Patent Appeals under the provisions of 35 U. S. C. 14), then the petitioner, if unsuccessful in the District Court, would have had the right to appeal under the provisions of 28 U. S. C. 1291 to the Court of Appeals for the District of Columbia. From an unsuccessful appeal to the Court of Appeals for the District of Columbia, review may be sought by peti-

tioning the Supreme Court for a writ of certiorari under the provisions of 28 U. S. C. 1254. Thus, if that alternative avenue of appeal had been chosen by petitioner, there would have been a right of one appeal plus an unquestioned right to seek further review by petitioning this Court for a writ of certiorari.

A denial of the right even to seek review of the ruling made by the *single court* that has heard petitioner's case, by a suggestion of lack of jurisdiction, is to be compared with the opportunities for review possible under the other avenue of appeal from the Patent Office. Such attempted denial of any possibility of review is also to be compared with the usual right of at least one appeal in other types of litigation.

2. Design Patents Are Also Patents for Inventions.

The brief for respondent raises a new theory or concept not encountered in the arguments below nor found in any of the decisions or literature. Repeatedly, the respondent's brief attempts to make a distinction, other than distinctions expressed in the statutes, between "*invention* patents" on the one hand and "*design* patents" on the other hand. Based upon such a premise, there is then advanced upon behalf of respondent the argument that such a distinction warrants the difference in the treatment given by the Patent Office, in respect to claiming of the disclosed inventions, between petitioner's application for a patent on his design and a so-called "*invention* patent" application.

The premise is in error because *all* patents granted by the Commissioner of Patents under the statutes are for *inventions*. That designs must embody *inventions* to be patentable is basic to our patent laws. The statute authorizing design patents, 35 U. S. C. 171, states, in part, that:

> "Whoever *invents** any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title."

Too many to cite are the decisions of the Patent Office and the courts repeating the requirements that design patents like non-design patents must embody inventions.

There is thus no warrant for attempting to justify the denial of the right of a design patent applicant to equal treatment under the patent statutes authorizing the *claiming of inventions* in both design and non-design cases. The only lawful distinctions are those expressed by the statutes, because the last paragraph of 35 U. S. C. 171 states that:

> "The *provisions of this title* relating to patents for inventions shall apply to patents for designs, except as otherwise provided."

3. The Statutory Function of Claims.

On page 10 of the brief for respondent, there is stated the following:

> "Since the function of the claim *in the design patent* is merely to refer the reader to the drawings, the necessity of permitting an inventor to express his invention in more than one claim, recognized in *invention* patents where the words of the claims are all important, does not exist in patent design cases."

The view there expressed is in conflict with the *only statute* which authorizes and requires claims in any patent, design or non-design. There is *no statute* making

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* Comparable with 35 U. S. C. 101 which provides: "Whoever *invents* or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

an exception in design patent cases to this sole authorization for patent claims found in 35 U. S. C. 12, to-wit:

> "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

The statutes do not provide any authority for the suggestion that "the function of the claim in the design patent is merely to refer the reader to the drawings."

4. This Court Has Recognized Plural Claims in Design Patents.

The respondent's brief has cited some decisions of the Commissioner of Patents supporting his own rule allowing but the one claim in design cases notwithstanding the lack of statutory basis for his decisions. However, this Court has passed on design patents with plural claims and did not rule against having plural claims because in a design patent.

This Court passed on a design patent having plural claims and held the patent with nineteen claims valid, in the case of:

Dobson et al. v. Hartford Carpet et al., 114 U. S. 439.

In another case involving a design patent having plural claims, this Court held one claim invalid and remanded to the trial court the question of the validity of two additional claims over the prior art. All three claims were verbal claims rather than merely formal claims referring to the drawing. There was no question as to the propriety of having three claims. This was the case of:

New York Belting Co. v. New Jersey Spring Co., 137 U. S. 445.

No statutory authority has intervened since those cases to support the Commissioner of Patents' decisions in favor of his own Patent Office Rule 153 curtailing the rights of those making *design inventions* to adequately claim their inventions under the general patent statutes.

5. Admission That 35 U. S. C. 121 Enacted in 1952 Should Apply.

It appears that the brief for respondent, in the last half of page 13, concedes that the provisions of 35 U. S. C. 121* should govern applications for patents on design inventions. Because the practice is so universally followed, and because no other manner of dealing with questions of division is known, it should be readily conceded that division under 35 U. S. C. 121 is always a division between *claims*. No case has been cited contrary to the statement that the only "units of invention" capable of being separated are claims.

Thus, when it is admitted, upon behalf of respondent, that in design cases the Commissioner *may require separation*, and upon the portion separated from the first application being filed in second application, it may be granted the statutory protection expressed in 35 U. S. C. 121, this concedes the full application of 35 U. S. C. 121 to design patent applications. If, as petitioner has insisted without success in the Patent Office and in the Court below, the provisions of 35 U. S. C. 121 apply to design patent applications, then there must be permitted a plurality of claims in design cases.

It inherently follows that there must be *multiple* claims to a *multiple* of "independent and distinct in-

* 35 U. S. C. 121 is new in the patent statutes and its provisions appear for the first time in the Patent Act of 1952.

ventions" in order for the Commissioner to require restriction to *one claimed* invention and for the applicant to be assured the statutory protection of 35 U. S. C. 121 when he files a divisional application on the *other claimed invention.*

In the proceedings in the Patent Office, there was made the request upon behalf of petitioner for a requirement of a restriction *under the provisions of* 35 U. S. S. 121 if the Patent Office considered that there were "two or more independent inventions claimed in one application." The Patent Office steadfastly and studiously refused to make such a requirement. The above admission now contained in the brief on behalf of respondent would appear to confess error on the part of the Patent Office and the Court below.

CONCLUSION.

The need for grant of a writ of certiorari has been demonstrated.

Respectfully submitted,

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Attorney for Petitioner.

February, 1960